

REMARKS

Applicant respectfully requests reconsideration and allowance in view of the following remarks. In the Office Action, mailed December 3, 2004, the Examiner rejected claims 1-3, 5-11, 13-19 and 21-51. Following entry of this reply, claims 1-3, 5-11, 13-19 and 21-51 will be pending in the application.

General Office Action Comment

In the Office Action, the Examiner noted on the Office Action Summary sheet that the office action was “[r]esponsive to communication(s) file on 17 November 2004.” Applicants’ last communication with the Patent Office in this case was the RCE and Amendment filed on September 2, 2004. Applicants’ undersigned representative called the Examiner and determined that the 11/17/04 date was merely a clerical error.

Drawings

Applicants submit a new, formal set of drawings for entry in this application. The new drawings are an electronic version of the hand drawings that Applicants previously submitted. No drawing objects have been made in this or previous office actions. No new matter is added in the new drawings. The new drawings are included as an attachment to this reply.

Applicants respectfully request entry of the replacement drawings.

Allowable Subject Matter

Applicants thank the Examiner for noting the allowability of most of the claimed subject matter in this application. Specifically, in the Office Action, the Examiner noted that claims 1-3, 5-11, 13-19, 21-24 and 25-48 would be allowable if rewritten or amended to overcome the §112 rejection(s). As discussed in further detail below, Applicants’ assert that claims 1-3, 5-11, 13-19,

21-24 and 25-48 are not indefinite. Further, the Examiner noted that claims 50-51 would be allowable if rewritten or amended to overcome the §112 rejection(s) and rewritten to include all of the limitations of the rejected base claim and any intervening claims. As also discussed in further detail below, Applicants assert that claims 50-51 are not indefinite and that independent claim 49, from which claims 50-51 ultimately depend, is patentably distinct over the art of record.

Therefore, for at least these reasons, Applicants respectfully request allowance of claims 1-3, 5-11, 13-19, 21-24, 25-48 and 50-51.

Claim Rejections under 35 U.S.C. § 112 (Second Paragraph)

In the Office Action, the Examiner rejected claims 1-3, 5-11, 13-19 and 21-51 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Specifically, the Examiner noted that, in independent “claims 1, 9, 17, 25, 37 and 49, it is unclear what is meant by ‘omits at least some of the processing for reception of valid data from the DSL channel.’” Office Action, ¶ 2 (emphasis in original). Applicants respectfully traverse the rejection of claims 1-3, 5-11, 13-19 and 21-51.

A rejection under 35 U.S.C. §112, second paragraph, is not appropriate when “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986).

The specification of the present application teaches in more than one location that at least in certain operation mode(s) of the disclosed transceiver, such as, for example, the SLEEP mode, at least part of the processing elements need not be utilized. Thus at least some of the processing

(performed by such processing elements) can be omitted. This disclosure can be found in various portions in the specification, for example, on page 6, lines 25-30, on page 7, lines 24-31, and on page 9, lines 18-20 and lines 24-28. As can be seen from these descriptive specification sections, the claimed element of “omits at least some of the processing” in claims 1, 9, 17, 25, 37 and 49 is well supported by the specification of the present invention, and thus those skilled in the art would readily be able to determine the metes and bounds of the invention.

For at least the foregoing reasons, Applicants respectfully request the withdrawal of the §112, second paragraph, rejections of claims 1-3, 5-11, 13-19 and 21-51.

Claim Rejections under 35 U.S.C. §102(e)

In the Office Action, the Examiner rejected claim 49 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,445,730 to Greszczuk (hereinafter “Greszczuk”). Applicants respectfully traverse the rejection of claim 49 because Greszczuk is an improper §102(e) reference.

According to MPEP §§ 706.02(f)(1) & 2136, references based on international applications that were filed prior to November 29, 2000 are subject to the pre-AIPA version of 35 U.S.C. §102(e). Greszczuk issued from a PCT application (i.e., an international application) that was filed on January 26, 1999, prior to Nov. 29, 2000. Thus, the pre-AIPA version of §102(e) applies to Greszczuk as a reference.

The pre-AIPA version of §102(e) states that a “person shall be entitled to a patent unless ... (e) the invention was described in a patent granted ... on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.” 35 U.S.C. §102(e). The §371(c)(1),(2),(4) date for Greszczuk, as printed on the front page of Greszczuk, is June 13,

2000. The date of invention for Applicants is at least by the constructive reduction to practice, or filing date of this application, March 15, 2000. Thus, because the Greszczuk §371(c)(1),(2),(4) date (6-13-00) is not before the date of Applicants' filing date (3-15-00), Greszczuk cannot properly be used as a §102(e) reference.

For at least the foregoing reasons, Applicants respectfully request the withdrawal of the §102 rejection of claim 49.

Conclusion

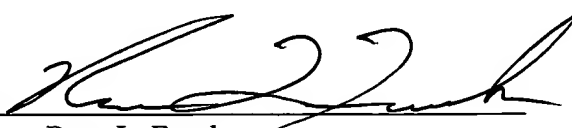
All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition of allowance and a Notice to that effect is earnestly solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

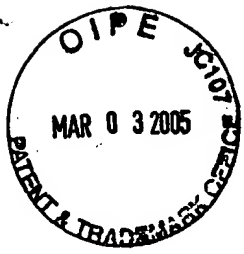
Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: 3/3/05

By: 
Ross L. Franks
Reg. No. 47,233

Attachments: Replacement Drawings Sheets (3)



Attachment
Replacement Drawing Sheets

IN THE DRAWINGS

Applicants submit a new, formal set of drawings for entry in this application. The new drawings are an electronic version of the hand drawings that Applicants previously submitted. The new drawing sheets are included as an attachment to this response.